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EXAMINER

SCHUBERT, KEVIN R

ART UNIT PAPER NUMBER

2137

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,753

Applicant(s)

FAYED ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18,20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18,20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20021104</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Claims 1-18,20, and 22-24 have been considered.

#### *Election/Restrictions*

5            Claims 25-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group(s), there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/14/05. Further, regarding the Species Requirement, Applicant has also elected to withdraw claims 19 and 21 from consideration.

#### *Claim Rejections - 35 USC § 101*

10            35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15            Claims 1,3-7, and 9-12 are rejected under 35 USC 101. The claims are directed to non-statutory subject matter. The method of independent claims 1 and 8 appears to be based on intangible steps which are not required to be stored on a tangible embodiment.

#### *Claim Rejections - 35 USC § 102*

20            The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

25            (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States  
30            only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-3 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Rudolph, U.S. Patent Application No. 2002/0005774.

As per claims 1 and 13, applicant describes a method comprising the following limitations which  
5 are met by Rudolph:

a) generating an electromagnetic field to energize the transponder ([0029]);

b) receiving from the transponder a value of an identification number of a copy of the computer  
program ([0022]);

c) analyzing the identification number value to determine whether the identification number value  
10 is valid ([0022]);

d) allowing or denying the installation of the copy of the computer program based on the  
analyzing step ([0022]).

As per claim 2, the applicant describes the method of claim 1, which is met by Rudolph, with the  
15 following limitation which is also met by Rudolph:

A computer-readable medium having stored thereon computer-executable instructions for  
performing the method of claim 1 (Rudolph: [0022]).

As per claim 3, applicant describes the method of claim 1, which is met by Rudolph, with the  
20 following limitation which is also met by Rudolph:

a) receiving a cryptologically-derived block of data transmitted by the transponder (Rudolph:  
[0026]);

b) analyzing the block of data using a secret algorithm that is commonly shared with the  
transponder to authenticate the computer software product (Rudolph: [0026]).

25

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Nerlikar, U.S. Patent No. 5,905,798, in further view of Bensky, U.S. Patent Application Publication No. 2003/0195723.

As per claim 7, applicant describes a method comprising the following steps which are met by Rudolph in view of Nerlikar in further view of Bensky:

a) executing an installation program of the software program, the installation program being stored on a computer software product comprising a transponder (Rudolph: [0022]);

b) in accordance with the installation program, sending a radio frequency signal to a reader that is linked to the computer, thereby causing the radio frequency reader to query the transponder for a product identification number of the computer software product, wherein the product identification number identifies the particular copy of the software package being installed (Rudolph: [0022]; Nerlikar: Col 2, lines 14-23; Bensky: [0009]);

c) analyzing the product identification number to determine whether it is valid (Rudolph: [0022]);

d) based on the analyzing step, determining whether or not to install the software on the computer (Rudolph: [0022]);

Rudolph describes a method which meets the limitations of parts a), c), and d). However, Rudolph does not describe "sending a radio frequency signal to a reader that is linked to the computer, thereby causing the radio frequency reader to query the transponder". The system of Rudolph may function by having a sensor device which activates a field and causes a radio frequency reader to query the transponder (Rudolph: [0028]). Rudolph is silent as to the placement of such a sensor. Nerlikar

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teaches a similar method in which a sensor is on a computer system. The insertion of a medium, such as a disk, into the computer system causes the transmission of an interrogation signal. Combining the ideas of Nerlikar with those of Rudolph allows the sensor to be placed at the computer system and to identify the insertion of a medium. It would have been obvious to one of ordinary skill in the art to combine the ideas of Nerlikar with those of Rudolph and have a sensor which identifies a medium placed at the computer system because doing so allows for an efficient means to recognize a medium and accordingly activate an electromagnetic field.

The system of Rudolph in view of Nerlikar meets all the limitations of claim 7 except for the limitation of "sending a radio frequency signal to a reader that is linked to the computer". It appears from Rudolph that the computer sends a signal from the computer system to the reader over a wired connection (see Fig 4). Bensky discloses the well-known idea of radio frequency communication. It would have been obvious to one of ordinary skill in the art to combine the ideas of Bensky with those of Rudolph in view of Nerlikar and have the communication between the computer system and the reader be radio frequency because radio frequency is an efficient means of communication which allows for the opportunity of wireless communication.

As per claim 8, the applicant describes the method of claim 7, which is met by Rudolph in view of Nerlikar in further view of Bensky, with the following limitation which is met by Rudolph:

A computer readable medium having stored thereon computer-executable instructions for performing the method of claim 7 (Rudolph: [0022]-[0023]).

As per claim 9, the applicant describes the method of claim 7, which is met by Rudolph in view of Nerlikar in further view of Bensky, with the following limitation which is met by Nerlikar:

Wherein the activating step comprises calling a function of an operating system of the computer to cause an activation signal to be sent to the reader (Nerlikar: Col 2, lines 14-23).

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As per claim 12, the applicant describes the method of claim 7, which is met by Rudolph in view of Nerlikar in further view of Bensky, with the following limitations:

a) if, according to the analyzing step, the product identification number is determined to be valid, retrieving user-defined configuration information from the transponder;

5           b) installing the software package on the computer (Rudolph: [0022]-[0023]);

c) configuring the software in accordance with the user-defined configuration information retrieved from the transponder;

Rudolph in view of Nerlikar in further view of Bensky disclose all the limitations of claim 7. The combination also discloses installing a software package on a computer (part b). However, the  
10 combination is silent as to the software being installed in accordance with user-defined configuration information. The examiner takes official notice that it is well-known in the art to retrieve user-defined configuration information upon execution of software. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to retrieve user-defined configuration information because doing so allows the software to execute according to user preferences.

15

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Nerlikar in further view of Bensky in further view of Brady, International Publication No. WO 00/23994.

As per claim 10, the applicant describes the method of claim 7, which is met by Rudolph, with the  
20 following limitations:

a) displaying to a user a field for entering the product identification number (Brady: page 22, line 22 to page 23, line 22);

b) performing the activating step in response to a user indicating a desire to have the product identification number automatically retrieved (Rudolph: [0022]-[0023]);

25           c) receiving the product identification number from the transponder (Rudolph: [0022]-[0023]);

d) populating the field with the received product identification number (Brady: page 22, line 22 to page 23, line 22);

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Rudolph discloses all the limitations of claim 7. Rudolph, however, does not disclose that a user enters a security code. Brady discloses the idea that a user enters a security code which is matched with a stored security code for authentication purposes. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Brady with those of Rudolph and have a user enter a security code because doing so enhances security in the system since a user must be aware of a security code.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Nerlikar in further view of Bensky in further view of Brady in further view of Menezes (Menezes, Alfred J. Handbook of Applied Cryptography. CRC Press. Washington DC. 1997. pages 388-389).

As per claim 11, the applicant describes the method of claim 10, which is met by Rudolph in view of Nerlikar in further view of Bensky in further view of Brady, with the following limitation:

a) soliciting the user for a username and password to use in conjunction with the software package (Brady: page 22, line 22 to page 23, line 23; Menezes: page 388-389);

b) storing the username and password in memory of the transponder (Brady: page 22, line 22 to page 23, line 23);

Rudolph in view of Nerlikar in further view of Bensky in further view of Brady disclose all the limitations of claim 10. However, the combination discloses soliciting a user for a password to use in conjunction with the software package and storing the password in memory of the transponder, not soliciting and storing a password AND a username. Menezes discloses the idea that it is common to use a password and a username together in an authentication system. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Menezes with those of Rudolph in view of Nerlikar in further view of Bensky in further view of Brady because requiring a password and a username for authentication enhances security since a user must know two forms of ID to be authenticated.



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Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Muroi, U.S. Patent No. 2002/0052238.

As per claim 16, the applicant describes the computer software product of claim 13, which is met  
5 by Rudolph, with the following additional limitation which is met by Muroi:

Wherein the computer-readable medium has stored thereon a game program, and the transponder has a memory having stored thereon data comprising status information regarding an in-progress game (Muroi: [0024]);

Rudolph discloses all the limitations of claim 13. However, Rudolph does not disclose storing  
10 game information on a transponder. Muroi discloses this feature in a system which utilizes transponder memory to store game information. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Muroi with those of Rudolph for the purpose of recording in-progress game information for future game play.

15 Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Yokoyama, U.S. Patent No. 6,094,293.

As per claim 17, applicant describes the computer software product of claim 13, which is met by Rudolph, with the following limitation which is met by Yokoyama:

20 Wherein the computer-readable medium is an disk, the computer software product further comprising a counterbalance member disposed on the computer-readable medium so as to reduce the wobble of the computer-readable medium as it spins (Yokoyama: Col 20, line 37-55);

Rudolph discloses all the limitations of claim 13. Rudolph is silent as to a counterbalance member. Yokoyama discloses the well-known idea that a counterbalance member may be used to  
25 counterbalance a system. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Yokoyama with those of Rudolph because doing so allows for a means to counterbalance the transponder and thereby reduce wobbling.

Claims 20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Nerlikar, U.S. Patent No. 5,905,798, in further view of Cicciarelli, U.S. Patent Application Publication No. 2002/0188941.

5

As per claim 20, applicant describes a system comprising the following limitations which are met by Rudolph in view of Nerlikar in further view of Cicciarelli:

a) a computer (Rudolph: [0022]-[0023]);

b) a computer-readable medium having stored thereon one or more programs including an  
10 installation program (Rudolph: [0022]-[0023]);

c) a transponder having stored thereon a number for identifying the computer software product (Rudolph: [0022]);

d) and a reader in communication with the computer (Rudolph: Fig 1);

e) wherein when the computer executes the installation program, the computer signals the reader  
15 to query the transponder for the number and analyzes the number to determine the authenticity of the computer software product (Rudolph: [0022]-[0023]; Nerlikar: Col 2, lines 14-23; Cicciarelli: [0009]);

Rudolph describes a method which meets the limitations of parts a) through d). However, Rudolph does not describe "when the computer executes the installation program, the computer signals the reader to query the transponder for the number". The system of Rudolph may function by having a  
20 sensor device which activates a field and causes a radio frequency reader to query the transponder (Rudolph: [0028]). Rudolph is silent as to the placement of such a sensor. Nerlikar teaches a similar method in which a sensor is on a computer system. The insertion of a medium, such as a disk, into the computer system causes the transmission of an interrogation signal. Combining the ideas of Nerlikar with those of Rudolph allows the sensor to be placed at the computer system and to identify the insertion of a  
25 medium. It would have been obvious to one of ordinary skill in the art to combine the ideas of Nerlikar with those of Rudolph and have a sensor which identifies a medium placed at the computer system because doing so allows for an efficient means to activate an electromagnetic field.

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The combination of Rudolph in view of Nerlikar describes a system in which when a computer detects that a medium is inserted, the computer signals the reader to query the transponder for the number. Rudolph in view of Nerlikar are silent as to how the computer detects that a medium has been inserted. Thus, Rudolph in view of Nerlikar fail to disclose that a computer detects that a medium has been inserted via an installation program. Ciciarelli discloses a computer may detect the insertion of a medium by identifying and automatically executing an installation program. Combining the ideas of Ciciarelli with those of Rudolph in view of Nerlikar allows the computer to detect that a medium has been inserted via an installation program. Once the system detects that a medium has been inserted, the computer signals the reader to query the transponder for the number. Thus, the combination of Rudolph in view of Nerlikar in further view of Ciciarelli meet the limitation "wherein when the computer executes the installation program, the computer signals the reader to query the transponder". It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Ciciarelli with those of Rudolph in view of Nerlikar because doing so provides for an effective means of determining the insertion of a medium.

As per claims 22-24, applicant describes the system of claim 20, which is met by Rudolph in view of Nerlikar in further view of Ciciarelli, with the following limitation which is also met by Rudolph:

A handheld input device, wherein the reader is integrated with the handheld input device (Rudolph: [0022]).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Edenson, U.S. Patent No. 6,198,875, in further view of Schneier (Schneier, Bruce. Applied Cryptography. 1996. John Wiley & Sons. Pages 173-174).

As per claim 4, the applicant describes the method of claim 3, which is met by Rudolph, with the following limitations which are met by Rudolph in view of Edenson in further view of Schneier:

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a) extracting a numerical value from the received block of data (Edenson: Col 3, lines 44-64; Rudolph: [0022]-[0023]);

b) comparing the numerical value with the received randomly generated number (Edenson: Col 3, lines 44-64; Schneier: pages 173-174);

5 Rudolph discloses all the limitations of claim 3. Rudolph does not comparing a numerical value with a received randomly generated number. Edenson discloses that a numerical value may be compared with a received decryption key. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Edenson with those of Rudolph because doing so allows for decryption capability of encrypted data.

10 Rudolph in view of Edenson fail to disclose that the decryption key is a randomly generated number. Schneier discloses the ideas that a key may be a randomly generated number. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Schneier with those of Rudolph in view of Edenson and have the key be a randomly generated number because doing so is an effective and secure method of key implementation.

15 Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph in view of Edenson.

As per claims 5 and 6, the applicant describes the method of claim 1 which is met by Rudolph,  
20 with the following limitation which is met by Edenson:

a) determining which version of the program is stored on the computer-readable medium (Edenson: Col 3, line 44 to Col 5, line 29);

b) determining whether the identification number is proper for the program version (Edenson: Col 3, line 44 to Col 5, line 29);

25 Rudolph discloses all the limitations of claim 1. However, Rudolph does not disclose the limitations of a) and b) above. These limitations are disclosed by Edenson. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Edenson with

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those of Rudolph because doing so allows the system to make a determination of a version and take appropriate action.

As per claims 14 and 15, the applicant describes the computer software product of claim 13,  
5 which is met by Rudolph, with the following limitation which is met by Edenson:

Wherein the transponder has a memory having stored thereon a secret algorithm shared with an installation program that controls the reader (Edenson: Col 3, line 44 to Col 4, line 37).

As per claim 18, the applicant describes the computer software product of claim 13, which is met  
10 by Rudolph, with the following limitation which is met by Edenson:

Wherein the transponder is attached to a surface of the computer readable medium (Edenson: abstract).

### ***Conclusion***

15 This action has been made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,  
20 Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through  
25 Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**EMMANUEL L. MOISE**  
**SUPERVISORY PATENT EXAMINER**